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09/803,272	03/09/2001	Philip K. Yu	998000 PA1	6375

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EXAMINER

AU, SCOTT D

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,272

Applicant(s)

YU ET AL.

Examiner

Scott Au

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-17 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

This communication is in response to applicant's response to an Amendment A which is filed January 26, 2004.

An amendment A to the claims 1-4 and 8-9 have been entered and made of record. The new set claims 11-17 are introduced.

Claims 1-17 are pending.

Response to Arguments

Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-9 and 14-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No where in the specification describe the limitation that "said memory being operationally independent of the operation of said electronic appliance". This limitation contains new subject matter.

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A control circuit remotely controls the operation of an electronic appliance in response to a user's pressing the numerical keys "0" to "9". The memory which stores the numerical key entered by the user. Therefore, the memory is being used to control an electronic appliance. From this rationale, it is not understood. How a memory can be operationally independent of operation of an electronic appliance when it is necessarily associated with the set of numeric keys as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11-13 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cullimore (US# 5,214,422) in view of Crowell (US# 5,387,108).

Referring to claims 1 and 3, Cullimore discloses a universal remote control ("URC") (14) (i.e. remote control transmitter) to control at least one electronic appliance (20) (i.e. control apparatus) (col. 3 lines 20-31; see Figure 1), comprising:

a housing (94,96) (i.e. support members);

a first control circuitry (i.e. see Figure 6) which, responsive to a user's command, remotely controls the operation of the at least one electronic appliance, the first control

circuitry (i.e. see Figure 6) being located within the housing (94,96) (i.e. support members) (col. 3 lines 20-43, col. 6 lines 46-60 and col. 7 lines 2-23; see Figures 1,4-6).

However, Cullimore did not explicitly disclose specifically of that a digital voice recorder, disposed within the housing, which records audio signal from both a user and the user's ambience and plays back said audio signal, responsive to a user's command; and couple means to attach the digital voice recorder to the housing.

In the same field of endeavor of voice recording device for use independently or in cooperative relationship with alternate products, Crowell teaches a digital voice recorder (20) (i.e. an audio message delivery system), disposed within the housing, which records audio signal from both a user and the user's ambience and plays back said audio signal, responsive to a user's command (30) (i.e. switch means); and couple means (36) (i.e. elongated tap) to attach the digital voice recorder to the housing (col. 2 lines 20-46 and col. 5 lines 33-68) in order to play the message whenever is desired.

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to include an audio message delivery system, disposed within the housing, which records audio signal from both a user and the user's ambience and plays back said audio signal, responsive to a user's command; and elongated tab to attach the audio message delivery system to the housing disclosed by Crowell into remote control of Cullimore with the motivation for doing so would allow convenience for the user to record surrounding sound and voice signal. Crowell further discloses loop type fastening (col. 7 lines 55-60) as a coupling means and Cullimore discloses Velcro, which is hook and loop fastener (col. 6 lines 61-64). One skilled in the

art understands that the remote control and voice recorder are separated devices.

Therefore, the remote control and voice recorder devices are operated independently of each other and can be coupled together with coupling means.

Referring to claims 2,4 and 11-13, Cullimore in view of Crowell disclose a universal remote control of claims 1 and 3, Crowell discloses wherein the digital voice recorder comprises: a microphone (27) (i.e. microphone) to receive the audio signal from both the user and the user's ambience; a processor (25) (i.e. integrated circuit chip) to process the received audio signal from said microphone (27); a memory (25) (i.e. memory is within integrated circuit chip) to store the processed received audio signal, said memory and said first control circuitry being operational independent of each other; a speaker (28) (i.e. speaker) to play back the audio signal, a power supply (26) (i.e. power means), and a second control circuitry (24) (i.e. of printed circuit board) to operate the digital voice recorder upon the user's command (col. 5 line 33 to col. 6 line 25; see Figure 1). Also, as stated in the independent claim 1 above, that one skilled in the art understands that the remote control and voice recorder are separated devices. Therefore, the remote control's circuitry and voice recorder's circuitry are operated independently of each other.

Referring to claim 5, Cullimore in view of Crowell disclose a universal remote control of claim 1, Cullimore disclose a couple means includes a Velcro fastener

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between a housing (92) (i.e. a base station) and remote controls (98, 100 and 102) (col. 6 lines 61-63; see Figure 5).

Referring to claims 16-17, Cullimore in view of Crowell disclose a universal remote control of claims 2 and 4, Cullimore in view of Crowell stated in the independent claim 1 above, that one skilled in the art understands that the remote control and voice recorder are separated devices. Therefore, the remote control's circuitry and voice recorder's circuitry are operated independently of each other.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cullimore (US# 5,214,422) in view of Crowell (US# 5,387,108) as applied to the claim 4 above, and further in view of Yoshida et al. (US# 6,256,354).

Referring to claim 10, Cullimore in view of Crowell disclose a universal remote control of claim 4 above. However, Cullimore in view of Crowell did not explicitly disclose wherein the memory includes a first-in first-out ("FIFO") memory to store a plurality of signals; memory control to selectively fast-forward, reverse, erase, playback, make permanent at least one of the plurality of the signals stored by the FIFO memory.

In the same field of endeavor of voice recording and playback phone system, Yoshida et al. disclose wherein the memory includes a first-in first-out ("FIFO") memory to store a plurality of signals; memory control to selectively fast-forward,

reverse, erase, playback, make permanent at least one of the plurality of the signals stored by the FIFO memory (col. 8 lines 20-43) in order to allow the user to playback at a remote location.

Therefore, it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to have add that wherein the memory includes a first-in first-out ("FIFO") memory to store a plurality of signals; memory control to selectively fast-forward, reverse, erase, playback, make permanent at least one of the plurality of the signals stored by the FIFO memory of system disclosed by Yoshida et al. into the system of Cullimore in view of Crowell with the motivation for doing so would allow the plurality of signals stored.

Claim Objections

Claims 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Referring to claim 6, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that a couple mean includes an elastic band wrapping around the housing.

Referring to claim 7, the following is a statement of reasons for the indication of allowable subject matter: the prior art fail to suggest limitations that a couple means includes at least one pair of clamps to attach the digital voice recorder to the housing.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kumar (US# 5,648,760) discloses a handheld device that can operate independently or cooperate with the homebase station.

Jones (US# 6,145,046) discloses a remote control with removable memory card directly with a variety of rendering devices.

Kikinis et al. (US# 5,812,870) disclose a PDA that can record voice and remotely control the electronic appliances.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Au whose telephone number is (703) 305-4680. The examiner can normally be reached on Mon-Fri, 8:30AM – 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached at (703) 305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

Scott Au

S.A.

MICHAEL HORABIK
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